

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte CHRISTOPHER M. POHRER

Appeal No. 2004-0050
Application No. 09/692,641



ON BRIEF

Before OWENS, TIMM and JEFFREY T. SMITH, *Administrative Patent Judge*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

Decision on appeal under 35 U.S.C. § 134

Applicant appeals the decision of the Primary Examiner's refusal to allow claims 1 to 10, 19 and 20, all of the pending claims in the application. We have jurisdiction under 35 U.S.C. § 134.¹

¹ In rendering this decision, we have considered Appellants' arguments presented in the Brief filed May 15, 2003 and the Reply Brief filed September 10, 2003.

THE INVENTION

The Appellant's claimed invention relates to a method of adjusting the height of a volleyball net. The method comprises securing two net standards in an upright position to a support surface. The net standards comprise a lower post section and an upper post section. The upper post section is slidably connected to the lower post section for telescoping movement. The method comprises operatively connecting a net-supporting cable to the upper post sections of the net standards in a manner so that a net extends downward from the net-supporting cable. The method further comprises tensioning the net-supporting cable to a net-supporting tension which is sufficiently great that the elevation of the two ends of the net's upper edge margin does not exceed the elevation of the mid-point of the net's upper edge margin by more than approximately 3/4" (2 cm) when the ends of the net's upper edge margin are at approximately the same elevation. The method also comprises moving the upper post section of the net standards between a raised and lowered position without reducing the tension of the cable below the net-supporting tension. (Brief, pp. 2-3). Claim 1 and 10 which are representative of the invention are reproduced below:

1. A method of adjusting the height of a volleyball net comprising:
securing first and second net standards to a support surface, such as a floor, in a manner so that the net standards extend up from the support surface in a generally

upright position, each net standard comprising a lower post section and an upper post section slidably connected to the lower post section for telescoping movement of the upper post section relative to the lower post section along a post axis between a raised position and a lowered position;

providing a net and cable assembly comprising a net and a net-supporting cable, the net having an upper edge margin and a cable-receiving sleeve at its upper edge margin, the upper edge margin having first and second ends and a mid-point midway between the first and second ends, the net-supporting cable extending through the cable-receiving sleeve of the net;

operatively connecting the net-supporting cable to the upper post sections of the first and second net standards in a manner so that the net is between the first and second net standards and extends downward from the net-supporting cable;

tensioning the net-supporting cable to a net-supporting tension which is sufficiently great that the elevation of the first and second ends of the net's upper edge margin does not exceed the elevation of the mid-point of the net's upper edge margin by more than approximately 3/4" (2 cm) when the first and second ends of the net's upper edge margin are at approximately the same elevation; and

moving the upper post sections of the first and second net standards between their raised and lowered positions without reducing the tension of the cable below the net-supporting tension.

10. A method of adjusting the height of a volleyball net comprising:

securing first and second net standards to a support surface, such as a floor, in a manner so that the net standards extend up from the support surface in a generally upright position, each net standard comprising a lower post section, an upper post section slidably connected to the lower post section for telescoping movement of the upper post section relative to the lower post section along a post axis between a raised position and a lowered position, and a drive mechanism operable to move the upper post section between its raised and lowered positions;

providing a net and cable assembly comprising a net and a net-supporting cable, the net having an upper edge margin and a cable-receiving sleeve at its upper edge margin, the upper edge margin having first and second ends and a mid-point midway between the first and second ends, the net-supporting cable extending through the cable-receiving sleeve of the net;

operatively connecting the net-supporting cable to the upper post sections of the first and second net standards in a manner so that the net is between the first and second net standards and extends downward from the net-supporting cable;

Appeal No. 2004-0050
Application No. 09/692,641

providing a tensioning mechanism on the upper post section of the first net standard;

using the tensioning mechanism to tension the net-supporting cable between the upper post sections of the first and second net standards to a net-supporting tension which is sufficiently great that the elevation of the first and second ends of the net's upper edge margin does not exceed the elevation of the mid-point of the net's upper edge margin by more than approximately 3/4" (2 cm) when the first and second ends of the net's upper edge margin are at approximately the same elevation;

operating the drive mechanism of the first net standard to move the upper post section of the first net standard between its raised and lowered positions without reducing the tension of the cable below the net-supporting tension, and to move the tensioning mechanism therewith; and

operating the drive mechanism of the second net standard to move the upper post section of the second net standard between its raised and lowered positions without reducing the tension of the cable below the net-supporting tension.

CITED REFERENCES

As evidence of unpatentability, the Examiner relies on the following references:

Senoh	4,122,451	Oct. 24, 1978
Burns	4,153,247	May 08, 1979
Koole	5,308,085	May 03, 1994

The Examiner rejected claims 1 to 6, 8 to 10, 19 and 20 under 35 U.S.C. § 103(a) as obvious over the combination of Koole and Burns; and claim 7 under 35 U.S.C. § 103(a) as obvious over the combination of Koole, Burns and Senoh. (Answer, pp. 3-5).

Appeal No. 2004-0050
Application No. 09/692,641

OPINION

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 1 and 10. In rejecting the subject matter of claims 1 and 10, the Examiner's relies on the combination of Koole and Burns. Therefore, we will limit our discussion to these references.

To hold an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the reference teachings and combine them in a way that would produce the claimed invention. *See, e.g., Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) (When the patent invention is made by combining known components to achieve a new system, the prior art must provide a suggestion, or motivation to make such a combination.); *Northern Telecom v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient to establish a *prima facie* case of obviousness based on prior art references disclosing the components of a patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the

Appeal No. 2004-0050
Application No. 09/692,641

combination made by the inventor.); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1044, 1051, 5 USPQ 1434, 1438 (Fed. Cir. 1988).

The Examiner rejected the claimed subject matter over the combination of Koole and Burns. According to the Examiner, Koole discloses two uprights (net standards) that comprise a lower post section and an upper post section. The Examiner asserts that the upper post section comprises the net attachment means and tensioning mechanism and is slidably connected to the lower post section for telescoping movement. (Answer, p. 4). The Examiner acknowledges that Koole does not disclose the specifics of the net. (Answer, p. 4). The Examiner cited the Burns reference to establish that cables used to tension the net are conventional and used on movable sleeves that can be raised and lowered. (Answer, p. 4). The Examiner asserts that Koole as modified by the teachings of Burns meets the structural limitations of the claimed invention. (Answer, p. 5). The Examiner further asserts the claimed method steps would have been met by a user of the modified invention of Koole which is inherently capable of height adjustment both before and after tensioning of the net-supporting cable. (Answer, p. 5).

We cannot uphold the Examiner's rejection. The method of appealed claims 1 and 10 requires tensioning the net-supporting cable to a net-supporting tension. The net-supporting tension is described as a tension that is sufficiently great that the

Appeal No. 2004-0050
Application No. 09/692,641

elevation of the two ends of the net's upper edge margin does not exceed the elevation of the mid-point of the net's upper edge margin by more than approximately 3/4" (2 cm) when the ends of the net's upper edge margin are at approximately the same elevation. The Examiner has not addressed this limitation of the claimed invention. Likewise, the Examiner does not address the step of raising or lowering the upper section of the net standards without reducing the tension of the net-supporting cable from the net-supporting tension. The Examiner's conclusion that the modified invention of Koole is inherently capable of height adjustment both before and after tensioning of the net-supporting cable does not indicate that the tension meets the requirements of the claimed invention. Assuming the Examiner is correct, that movement under tension is possible, there is no evidence that a person of ordinary skill in the art would have necessarily used a tension that is sufficient to meet the present claims. *Inherency* cannot be established by probabilities or possibilities. *See In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). As stated in *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (quoting from *In re Oelrich*, 666 F.2d at 581, 212 USPQ at 326), “[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency]” (emphasis in original). Under these circumstance, we cannot conclude that the Examiner has met the minimum threshold of establishing.

Appeal No. 2004-0050
Application No. 09/692,641

CONCLUSION

Based on our consideration of the totality of the record before us, we reverse the rejections of claims 1 to 10, 19 and 20 for the lack of the presentation of a *prima facie* case of obviousness.

REVERSED

Terry J. Owens)
TERRY J. OWENS)
Administrative Patent Judge)
Catherine Timm)
CATHERINE TIMM)
Administrative Patent Judge)
Jeffrey T. Smith)
JEFFREY T. SMITH)
Administrative Patent Judge)
BOARD OF PATENT
APPEALS AND
INTERFERENCES

JTS/kis

Appeal No. 2004-0050
Application No. 09/692,641

THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST. LOUIS, MO 63101